

Applicants : Anthony A. Sauvé and Vern L. Schramm  
Serial No. : 10/038,760  
Filed : January 4, 2002  
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34 (original): The compound of claim 4, wherein D is a primary alcohol or hydrogen.

35 (original): The compound of claim 5, wherein D is a primary alcohol or hydrogen.

36 (original): A pharmaceutical composition comprising the compound of claim 3 and a pharmaceutically-acceptable carrier.

37 (original): A pharmaceutical composition comprising the compound of claim 4 and a pharmaceutically-acceptable carrier.

#### Remarks

Claims 1-37 are pending in the instant application. Claims 6-9, 12-13, 16-17 and 20-29 are withdrawn from consideration as being directed to non-elected embodiments, and claims 1-5, 10, 11, 14, 15, 18, 19 and 30-37 stand rejected. Claims 1 and 3 are amended herewith to more particularly point out and distinctly claim the invention.

#### Rejections under 35 U.S.C. 112, second paragraph

Claims 1-5, 10, 11, 14, 15, 18, 19 and 30-37 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The holding of indefiniteness is based on asserted indefinite aspects of claims 1 and 3.

Claims 1 and 3 have been amended as follows. Claim 1 is amended, first, to eliminate the parenthesis around the "A" moiety in the recited structure, and second, to

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clarify that D cannot be a phosphoryl group (or a pyrophosphoryl group) by itself, but it can be an oxygen, nitrogen, carbon or sulfur linked to a phosphoryl (or pyrophosphoryl) group. Applicants believe that the carriage returns and indentations provided in the amended claim 1 clarify any ambiguities that may have been present.

Claim 3 has been amended to eliminate the objected-to “substituted pyridyl” and “substituted pyrimidyl” language.

In light of the amendments to claims 1 and 3, applicants respectfully request withdrawal of the rejections under 35 U.S.C. 112, second paragraph.

#### Rejections under 35 U.S.C. 102(a)

Claims 1-4, 10-11 and 30-32 stand rejected under 35 U.S.C. 102(a) as being anticipated by Sauvé et al., August 2000, J. Am. Chem. Soc. 122:7855-7859. Applicants request reconsideration and withdrawal of this rejection in light of the enclosed Declaration of the Inventors and the following discussion.

As established by the enclosed Declaration of the Inventors, the work disclosed in Sauvé et al. was the inventors' own work, and is therefore not available as a prior art reference under 35 U.S.C. 102(a). See *In re Katz*, 215 USPQ 14, 17 (“...one's own work is not prior art under §102(a) even though it has been disclosed to the public in a manner or form which otherwise would fall under §102(a). Disclosure to the public of one's own work constitutes a bar to the grant of a patent claiming the subject matter so disclosed [or subject matter obvious therefrom] only when the disclosure occurred more than one year prior to the date of the application ...”). A Declaration of the type presented herewith is also sufficient to establish that inventors Schramm and Sauvé are the sole inventors and thus remove the Sauvé et al. reference against the presently claimed subject matter. *In re Katz*, 215 USPQ at 16.

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Based on the above discussion, Sauvé et al. cannot be used as prior art against the instant invention. Accordingly, applicants respectfully request withdrawal of the rejection under 35 U.S.C. 102(a) based on Sauve et al..

Claims 1-3, 10, 11, 14, 15, 18, 30-33 and 36 also stand rejected under 35 U.S.C. 102(a) as being anticipated by Von Borstel et al., U.S. Patent No. 6,103,701. Specifically, it is asserted that Von Borstel et al. provides a compound in column 5, formula III that is encompassed within the scope of the cited claims. Applicants respectfully request reconsideration and withdrawal of these rejections in light of the claim amendments and the following discussions.

Claims 1 and 3 as amended do not encompass the structure provided in Von Borstel et al. Accordingly, applicants assert that Von Borstel et al. does not anticipate claims 1-3, 10, 11, 14, 15, 18, 30-33 or 36. Applicants also believe that the claimed compounds are not obvious in light of Von Borstel et al., since the Von Borstel et al. compounds are directed only to substituted purine or pyrimidine compounds. Von Borstel et al. does not suggest, nor would the skilled artisan believe, that any of the compounds claimed in the instant application would be useful for the purposes of the Von Borstel et al. invention, which is directed toward providing compounds that help in the recovery of damaged tissue. Since only purines or pyrimidines would be expected to be useful for the Von Borstel et al. invention, the compounds recited in the instant claims, which are not purines or pyrimidines, would not be expected to be useful for the Von Borstel et al invention.

In light of the claim amendments and the above discussion, applicants respectfully request withdrawal of the current rejections under 35 U.S.C. 102(a).

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Conclusion

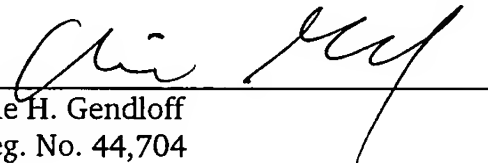
In light of the claim amendments and the discussion provided above, applicants believe that claims 1-5, 10, 11, 14, 15, 18, 19 and 30-37 are patentable with respect to the elected species, i.e., nitrogen linked heterocyclic groups. Accordingly, applicants request withdrawal of all current rejections and examination of the entire claim set, claims 1-37, with respect to the non-elected groups. If there are any minor issues preventing examination of the claims with respect to the non-elected groups, applicants request that Examiner McIntosh contact the undersigned attorney.

It is believed that no fee is required with this Amendment and Reply. However, if there is an unexpected fee required to maintain the pendency of this application, authorization is hereby given to charge that fee, or credit any over-payment, to Deposit Account No. 01-1785.

Respectfully submitted,

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By   
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